

## REMARKS

Claims 1, 29-32, and 35-43 are pending. Claims 1, 29-32, 35-40, 42, and 43 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1, 29-32, 35-40, and 42 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting. Each of these issues is addressed below.

### Amendments

Applicants have amended claims 1 and 39 to incorporate the limitation of claim 30. For the record, Applicants do not agree with the rejections raised in this case but wish to pursue the cancelled subject matter in a later continuation application and reserve the right to do so. In addition, Applicants have added new claims 44-52. These claims find support in the original claims and in the specification at page 11, lines 10-18; page 17, lines 10-14; and Table 1, where the recited insertions are described. These amendments add no new matter.

### Claim 41

Applicants note that claim 41 is apparently allowable and clarification of its status is requested.

### Rejections under 35 U.S.C. § 112, first paragraph

Claims 1, 29-32, 35-40, 42, and 43 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement or written description requirements. The Office acknowledges that Applicants' specification provides a disclosure demonstrating that insertions at AAV amino acid 587 (which Applicants clarify is an amino acid present in the overlapping sequences of each of VP1, VP2, and VP3) result in particle formation and increased infectivity, thereby satisfying both written description and enablement requirements (Office Action, pages 7 and 8). As applied to the amended

claims, therefore, these rejections may be withdrawn.

Moreover, new claims 44-52 are free of the § 112 rejections as the new claims do not require either AAV particle formation or increased infectivity, the Office's concerns underlying the rejections.

The § 112, first paragraph rejections may be withdrawn.

#### Obviousness-Type Double Patenting

Claims 1, 29-32, 35-40, and 42 stand further provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 121, 122, 130, and 143 of co-pending Application No. 10/498,163. Applicants wish to defer response to this rejection until such time as allowable subject matter in the '163 application and otherwise allowable subject matter in the present case have been indicated.

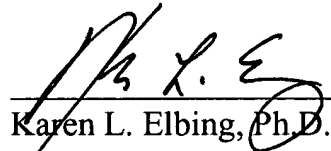
CONCLUSION

Applicants submit that the claims are now in condition for allowance, and such action is respectfully requested.

If there are any charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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Karen L. Elbing, Ph.D.  
Reg. No. 35,238

Clark & Elbing LLP  
101 Federal Street  
Boston, MA 02110  
Telephone: 617-428-0200  
Facsimile: 617-428-7045